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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Kathryn M. Ireland, Inc.

Serial No. 76976356

Anthony M. Keats of Keats McFarland & Wilson LLP for
Kathryn M. Ireland, Inc.

Raul Cordova, Trademark Examining Attorney, Law Office 114
(Margaret Le, Managing Attorney).

Before Seeherman, Walters, and Drost, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

This appeal involves a divisional application (Serial
No. 76976356) for the mark KATHRYN IRELAND (typed) for
"interior decorating services and interior decoration
consultation services" in Class 42. The parent application
(Serial No. 76230879) was filed on March 26, 2001, and is
now abandoned. The goods in the parent application at the
time of the request for division were "lamp shades" in
Class 11, "fitted fabric furniture covers, furniture,
namely, living room and bedroom" in Class 20, and "printed

fabrics, namely, cotton, hemp linen, ramie and silk;
draperies and curtains, upholstery fabrics, pillow cases,
shams, table cloths, not of paper, table linen, table mats
not of paper, table runners, fabric, unfitted fabric
furniture covers" in Class 24. The parent and child
applications contain an allegation of a date of first use
and first use in commerce of September 1997.

The examining attorney refused to register applicant's
mark on the ground that when the mark is used in connection
with the identified services, it so resembles the
registered mark, KATHY IRELAND HOME (typed), for the
following goods as to be likely to cause confusion, to
cause mistake or to deceive.¹ 15 U.S.C. § 1052(d).

Electric lighting fixtures and lamps in Class 11.

Furniture, namely, dining room, living room, kitchen,
bedroom, occasional, casual, and upholstered
furniture; wall units in Class 20.

Tapestries of textiles, bed linen, fabrics for the
manufacture of home furnishings, textile wall
coverings and table linen in Class 24.

Rugs, carpets, wall hangings not of textile, wallpaper
and mats, namely, textile floor mats for use in the
home in Class 27.

¹ Registration No. 2,686,945 issued February 11, 2003.

The registration also contains a disclaimer of the word "Home"² and it identifies "Kathy Ireland" as a living individual whose consent to register is of record.

The examining attorney's position (Brief at 3) is that "Applicant's mark, KATHRYN IRELAND, has the same surname that appears in registrant's mark, IRELAND, and [the] first name shown in applicant's mark, KATHRYN, has the same KATH prefix as the name shown in registrant's mark, KATHY, making them both look and sound alike." The examining attorney also submits that interior decoration services and home furnishings goods that serve to decorate the house are related.³

Applicant's position is that "Applicant is a famous interior designer who designs homes for movie stars and other distinguished clientele. Registrant is a famous supermodel who provides affordable 'solution oriented furniture' for 'families, especially busy moms.'" Appeal

² Actually, Office records indicate that registrant has disclaimed the words "Home Collection." Registrant's mark, which was first cited as a pending application, was originally for the mark KATHY IRELAND HOME COLLECTION and the application contained a disclaimer of the term "Home Collection." The registration subsequently issued with the mark listed as KATHY IRELAND HOME.

³With his brief, the examining attorney has submitted a dictionary definition of "interior decoration" as the "painting and execution of the layout, decoration and furnishing of an architectural interior. Also called *interior design*." We take judicial notice of this definition. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

Brief at 2-3, quoting, registrant's website, which is of record. Applicant further argues that the examining attorney "failed to consider and give proper weight to the word HOME in the cited mark and the obvious differences between KATHRYN and KATHY." Regarding the relationship of the goods and services, applicant maintains (Brief at 6) that "it is highly unlikely that one providing goods to the general public will also provide services to select clientele."

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In most likelihood of confusion cases, "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We begin our analysis by comparing the marks, which in this case are KATHRYN IRELAND and KATHY IRELAND HOME.

Obviously, both marks have the identical word IRELAND. The first word in both marks begins with the identical four letters "Kath" and they are both first names, KATHRYN and KATHY. While these names are not identical, they would be easily recognized as first names that look and sound similar.⁴ Furthermore, since KATHY and KATHRYN are similar first names and Kathy can be a shortened form of Kathryn, the names would have similar meanings and commercial impressions.

We are mindful of the fact that registrant's mark is not limited to the name KATHY IRELAND, rather that the mark is KATHY IRELAND HOME. It is the entire mark that we must compare to applicant's mark in determining whether the marks are similar. We note that, while registrant has included the word "Home" in its mark, it has disclaimed the term. Furthermore, inasmuch as registrant's goods include "floor mats for the home," "fabrics for the manufacturing of home furnishings," and furniture for the home, e.g., "dining room, living room, kitchen, [and] bathroom" furniture, the term obviously has a descriptive connotation and it is less likely to be relied upon by prospective

⁴ Indeed, in its Reply Brief (p. 3), applicant points out that they are variations of the name "Katherine." We will take judicial notice of applicant's dictionary definition that indicates the root of the name "Katherine" and its variations.

purchasers to distinguish the sources of the goods and services. Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), quoting, In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985) ("Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.'"). See also In re Code Consultants Inc., 60 USPQ2d 1699, 1702 (TTAB 2001) ("Disclaimed matter is often 'less significant in creating the mark's commercial impression"). In the mark KATHY IRELAND HOME, the term "Home" merely indicates that the goods are oriented toward use in the home.

Regarding the names in the marks, applicant argues (Brief at 2-3) that applicant "is a famous interior designer [and] Registrant is a famous supermodel."⁵ Applicant has included evidence that shows the recognition that the named individuals have received. Applicant apparently argues that the fame of the two individuals is a factor that makes confusion unlikely. However, to the

⁵ We note that in fact applicant and registrant appear to be corporations established by the named individuals. We too will refer to the individual and the corporation interchangeably.

extent that Kathy Ireland has achieved fame, such fame does not make confusion less likely.

The Board erred in discounting the import of Kenner's famous prior mark. The Board acknowledged "the renown of opposer's mark with respect to modeling compound." Indeed, Rose Art conceded this fame. Yet the Board treated that fame as a liability in assessing likelihood of confusion. Reasoning that consumers might more easily recognize variances from a famous mark, the Board concluded that the fame of Kenner's mark permitted greater, rather than less, legal tolerance for similar marks.

Kenner Parker Toys Inc. v. Rose Art Industries, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

When we compare the marks in their entirety, we find that the differences pale by comparison with their similarities. See In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) (There "is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of the mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entirety"). See also In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (Court held that the addition of "The," "Cafe" and a diamond-shaped design to registrant's DELTA mark still resulted in a likelihood of confusion). The differences in the first names, KATHRYN and KATHY, may not even be noticed by some purchasers. Those that do

notice the difference may simply assume that the marks still identify the same individual. We also keep in mind that human memories are not infallible and that consumers will not necessarily be viewing the marks in a side-by-side comparison. See In re Research and Trading Corp., 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) and Grandpa Pigeon's of Missouri, Inc. v. Borgsmiller, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973). We must focus on the general recollection reasonably produced by applicant's and registrant's marks. Johann Maria Farina Gegenuber Dem Julichs-Platz v. Chesebrough-Pond, Inc., 470 F.2d 1385, 176 USPQ 199, 200 (CCPA 1972).

Looked at in this way, we determine that the marks KATHY IRELAND HOME and KATHRYN IRELAND are similar in sound, appearance, meaning, and commercial impression such that, if the goods and services are related and other factors are not dispositive, there would be a likelihood of confusion.

The next factor we consider is the relationship between applicant's services and registrant's goods. "In order to find that there is a likelihood of confusion, it is not necessary that the goods on which or services in connection with which the marks are used be identical or even competitive. It is enough if there is a relationship

between them such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association between their sources." McDonald's Corp. v. McKinley, 13 USPQ2d 1895, 1898 (TTAB 1989). See also In re Opus One Inc., 60 USPQ2d 1812, 1814-15 (TTAB 2001).

Applicant argues (Reply Brief at 4, emphasis in original) that the examining attorney "failed to consider the unique and extraordinary services provide by Applicant... purchasers of Applicant's services are sophisticated, wealthy, select clientele. Applicant provides her services to her customers on an individual basis by referral, tailoring her unique services to each of her [clients] according to their discriminating tastes." However, applicant has identified its services as interior decorating services and interior decoration consultation services without any limitations. To the extent that applicant is arguing that these factors are limitations of its services, it is clear that we must consider the services as they are identified in the application and registration. Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of

goods"); Dixie Restaurants, 41 USPQ2d at 1534 (punctuation in original), quoting, Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1816 (Fed. Cir. 1987) ("Likelihood of confusion must be determined based on an analysis of the mark applied to the ... services recited in applicant's application vis-à-vis the ... services recited in [a] ... registration, rather than what the evidence shows the ... services to be"). Similarly, we do not limit registrant's goods to "ordinary and inexpensive home furnishings sold by Applicant." Reply Brief at 5. We cannot read limitations into the registration so that the identified goods are limited to the actual goods on which registrant is currently using the mark. Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983)("There is no specific limitation and nothing in the inherent nature of Squirtco's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations into the registration"). Therefore, we must assume that registrant is using its mark on all types of furniture, lighting fixtures, tapestries, and rugs including those that would be sold to or by interior

decorators.⁶ In addition, applicant's services as identified can be rendered by anyone authorized to use the mark by applicant corporation. Although, as applicant argues, Ms. Ireland may currently be providing her services to her customers on an individual basis, the identification of services is not restricted in this manner.

Furthermore, the examining attorney has provided evidence in the form of use-based registrations that suggest that applicant's services and registrant's goods may originate from the same source. See Registration Nos. 1,183,017 (interior decorating services and custom design of household linens and table cloths, napkins, and cloth placements); 1,340,749 (interior decorating services and furniture); 1,367,331 (interior decorating services and upholstered and wood furniture); 1,514,646 (interior decorating services and textile fabrics for use in

⁶ To the extent that applicant is arguing that it is a provider of services and registrant uses its mark on goods, we do not see this fact as significant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988) ("The only aspect of this case which is unusual is that the marks sought to be registered are for services while the prior registration on which their registration is refused is for wares. Considering the facts (a) that trademarks for goods find their principal use in connection with selling the goods and (b) that the applicant's services are general merchandising -- that is to say selling -- services, we find this aspect of the case to be of little or no legal significance").

upholstery and window treatment); and 1,801,318 (interior decorating services and electric lamps and household furniture).

These registrations provide at least some support for the examining attorney's argument that there is a relationship between applicant's goods and services. See In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) (Although third-party registrations "are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may have some probative value to the extent that they may serve to suggest that such goods or services are the type which may emanate from a single source"). See also In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993). We also note that applicant itself appears to agree (Brief at 6) that "it appears to be true that a few interior decorators or designers will offer goods under their respective marks."⁷

The record supports the examining attorney's position that interior decorating services and furniture and fabrics for home furnishings, and other home furnishings are

⁷ Applicant itself originally filed a use-based application that included, in addition to the interior decorating services, lamp shades, furniture, and printed fabrics.

related. In addition, applicant's services also include interior decoration consultation services. Thus, a purchaser familiar with registrant's furniture, fabrics, rugs, and similar products would likely believe that there is some association or relationship when a similar mark is used in association with interior decorating and interior decoration consultation services.

While applicant also argues (Brief at 4) that "consumers of Applicant's services are wealthy and exercise a high degree of care," this fact does not point to a lack of confusion. First, as indicated previously, applicant's services are not limited to wealthy purchasers. While wealthy individuals are consumers of interior decorating services, there is no evidence that interior decorating services as well as interior decoration consultation services are only purchased by wealthy purchasers. Second, there is certainly no evidence that purchasers of lighting fixtures, furniture, rugs, and similar goods are necessarily careful. Third, even if we were to find that the customers of applicant's services are careful purchasers, this would not mean there would be no likelihood of confusion when marks as similar and goods and services as related as those in this case are involved. See In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687,

1690 (Fed. Cir. 1987) ("[T]his court held that even sophisticated purchasers can be confused by very similar marks"); In re Hester Industries, Inc., 231 USPQ 881, 883 (TTAB 1986) ("While we do not doubt that these institutional purchasing agents are for the most part sophisticated buyers, even sophisticated purchasers are not immune from confusion as to source where, as here, substantially identical marks are applied to related products").

In conclusion, when the marks KATHRYN IRELAND and KATHY IRELAND HOME are used on the identified goods and services, confusion is likely.

Decision: The refusal to register applicant's mark under Section 2(d) is affirmed.